

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

10

REMARKS

Claims 6-8, 23-33, and 36-47 are all the claims presently pending in the application.

Claims 1-5, 9-22, 34, and 35 have been canceled without prejudice or disclaimer to the filing of divisional application(s) directed to these claims.

Claim 36 is amended to define more clearly the features of the present invention, thereby overcoming the rejection under 35 U.S.C. § 101.

New claims 37-47 are added to provide more varied protection for the present invention.

Applicant notes that no excess claim fee are due since claims 1-5, 9-22, 34, and 35 have been canceled.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claim 36 stands rejected under 35 U.S.C. § 101.

Claims 6-8, 23-33, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Egger et al. (U.S. Patent No. 6,233,571; hereinafter "Egger") in view of Anupam et al. (U.S. Patent No. 5,991,796; hereinafter "Anupam").

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention is directed to a collaborative Web research method.

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

11

In an illustrative, non-limiting embodiment of the invention, as defined by independent claim 6, a Web-based collaborative research method includes determining coordinates for pages which are retrieved by a first user and mapping the coordinates into a space, and based on the coordinates of the pages, informing a second user of a closeness of a research by the first user.

In another exemplary embodiment of the invention, as defined by independent claim 23, a Web-based collaborative research system includes a unit for determining coordinates for pages which are retrieved by a first user and mapping the coordinates into a space, and a notifier for informing, based on the coordinates of the pages, a second user of a closeness of a research by the first user.

Claim 36 recites somewhat similar embodiments of the invention, but is directed to a signal-bearing medium tangibly embodying a program of recordable, machine-readable instructions executable by a digital processing apparatus to perform a Web-based collaborative research method.

In the spatial navigation model according to the claimed invention, the data blocks (Web pages, pictures and so forth) are indexed such that each data block resides in a specific point in a N-dimensional coordinate system. The placement of the data blocks in this coordinate system is performed such that data blocks which are relatively "close" to each other are related to the same subjects (e.g., see specification at page 14, lines 15-20).

Moreover, the claimed invention provides a World Wide Web Portal which is capable of correlating the usage habits of each human researcher and is capable of notifying a researcher of a given topic that other researchers are currently working in related topics. This facility can be used by researchers to find potential collaborators for a research task, and can be used in

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

12

knowledge management applications at research institutions (e.g., see specification at page 11, lines 18-23).

With the claimed invention, researchers can engage in efficient collaborative research. Further, the portal of the invention can correlate the usage habits of each human researcher and can automatically (or otherwise) notify a researcher of a given topic that other researchers are currently working in related topics (e.g., “close” topics) (e.g., see specification at page 12, lines 1-5).

II. REJECTION UNDER 35 U.S.C. § 101

Claim 36 stands rejected under 35 U.S.C. § 101.

Applicant amends claim 36 to define more clearly the features of the invention, thereby overcoming this rejection.

Thus, the Examiner is requested to reconsider and withdraw this rejection.

III. THE PRIOR ART REJECTION

Claims 6-8, 23-33, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Egger in view of Anupam. Applicant traverses this rejection for the following reasons.

A. In the Response to Arguments, the Examiner states that Applicant’s arguments have been considered but that they are not persuasive.

The Examiner also alleges that Applicant’s arguments did not comply with 37 C.F.R. § 1.111 because they allegedly do not point out the novelty of the claims. The Examiner also

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

13

states that Applicant's remarks could not be imported into the claim and could not be considered by the Examiner.

Applicant respectfully submits that the Examiner's statements are not understood.

Applicant notes that the Amendment filed on December 6, 2004 clearly pointed out and identified the specific language of the claims which Applicant believes distinguishes the invention from the prior art of record (e.g., see Amendment under 37 C.F.R. § 1.116 filed on December 6, 2004, at page 21).

Applicant also presented traversal arguments in response to each of the Examiner's stated positions (e.g., see Amendment under 37 C.F.R. § 1.116 filed on December 6, 2004, at pages 21-22). Applicant clearly argued that it would not have been obvious to combine the references, and even assuming *arguendo* that such references would have been combined, that the resulting combination would not arrive at all of the features of the claimed invention (e.g., see Amendment under 37 C.F.R. § 1.116 filed on December 6, 2004, at pages 21-22).

Thus, the Amendment filed on December 6, 2004 clearly complied with 37 C.F.R. § 1.111.

Applicant believes that the Examiner's statements are intended to mean that the Examiner was not persuaded by the "substance" of Applicant's "remarks" in the December 6, 2004 Amendment, not that the "remarks" themselves did not comply with 37 C.F.R. § 1.111. Again, the remarks set forth in the Amendment filed on December 6, 2004 clearly complied with 37 C.F.R. § 1.111.

Applicant notes that, where Applicant traverses any rejections, the Examiner should, if he repeats the rejection, take note of the Applicant's argument and answer the substance of it (see M.P.E.P. § 707.07(f)).

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

14

Thus, Applicant respectfully submits that the Examiner should have responded to all of Applicant's traversal positions and answered the substance of the arguments (e.g., see M.P.E.P. § 707.07(f); see also M.P.E.P. § 2144.08(III)).

In this case, the Examiner merely acknowledged that there must be some motivation or suggestion to combine or modify the references, and then simply reiterated the previous "Response to Arguments".

Applicant respectfully reiterates, however, that the Examiner properly should have responded to all of Applicant's traversal positions and answered the substance of those arguments.

Accordingly, Applicant's remarks below again address the Examiner's position which has been reiterated in the "Response to Arguments" of the present Office Action.

B. Turning to the merits of the Examiner's Response to Arguments, the Examiner reiterates that:

Egger teaches determining coordinates for pages (algorithm is used to determine coordinates, col 6, lines 15-25) which are retrieved by a first user and mapping the coordinates into a space (col 6, lines 6-50); and based on said coordinates (col 36, lines 18-40) of said pages (col 48, lines 19-45), closeness of a research (col 7, lines 54-67, col 48, lines 63-67 and col 5, lines 38-48).

Anupam discloses informing a second user by first user (surrogate, 153, 173, fig 1, col 1, lines 66-67 and col 2, lines 1-8).

Therefore it would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teaching of (sic) Egger with Anupam because Anupam's use of creating surrogate for the user and inter surrogate communication would provide Egger's system with a (sic) user friendly computerized, web enabled, and an intelligent research tool that emulates human methods of research.

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

15

(see Office Action at pages 8-9, numbered paragraph 21; emphasis added).

Applicant respectfully disagrees with the Examiner's position, and therefore, traverses this rejection.

To summarize, Applicant respectfully reiterates that it would not have been obvious to modify Egger based on Anupam to arrive at the claimed invention. Applicant also submits that, even assuming *arguendo* that it would have been obvious to combine these references, the resulting combination would not arrive at the claimed invention.

For example, independent claim 6 recites a Web-based collaborative research method, including:

determining coordinates for pages which are retrieved by a first user and mapping the coordinates into a space; and

based on said coordinates of said pages, informing a second user of a closeness of a research by said first user
(emphasis added).

The claimed invention provides a Web based collaborative research method which informs a second user of a **closeness** of a research by a first user. That is, in stark contrast to the cited references, the present invention does not merely notify another researcher of *changes* of a uniform resource locator (URL) of a user. Instead, the claimed Web-based collaborative research method notifies the second user of a "**closeness**" of the first user's research.

This feature clearly is not disclosed or suggested by Egger and Anupam, either individually or in combination.

As the Examiner surely knows, each and every element of the claims must be disclosed or suggested by the alleged combination of references.

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

16

In this case, the alleged combination clearly does not disclose or suggest at least a Web-based collaborative research method which includes “based on said coordinates of said pages, informing a second user of a closeness of a research by said first user”, as recited in independent claim 6 (emphasis added).

In other words, the claimed invention is capable of correlating the usage habits of each human researcher and is capable of notifying a researcher of a given topic that other researchers are currently working, or have worked on, in related topics. This facility can be used by researchers to find potential collaborators for a research task, and can be used in knowledge management applications at research institutions (e.g., see specification at page 11, lines 18-23).

Moreover, with the claimed invention, researchers can engage in efficient collaborative research. Further, the portal of the invention can correlate the usage habits of each human researcher and can automatically (or otherwise) notify a researcher of a given topic that other researchers are currently working in related topics (e.g., see specification at page 12, lines 1-5).

As mentioned above, Applicant submits that merely teaching a graphic user interface, as taught by Eggers, is not comparable to the claimed Web-based collaborative research method which informs a second user of a closeness of a research by the first user based on the coordinates of the pages, as recited, for example, by independent claim 6.

Also, in stark contrast to the claimed invention, Anupam merely discloses a collaborative browsing session (e.g., see Anupam at Abstract). That is, Anupam merely permits the users to follow the browsing of other users. Anupam is silent with respect to a determination of the **closeness** of the research.

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

17

Particularly, Anupam discloses that, when one of the surrogates detects a change by a collaborator of a uniform resource locator (URL), the new URL is communicated through controllers to the surrogates of all other collaborators in the session.

Thus, the collaborators are able to move from one URL to another to browse information in a synchronous manner (e.g., see Anupam at Abstract; see also column 2, lines 36-39; and column 4, lines 29-32).

However, Applicant respectfully submits that merely informing the collaborators of a change from one URL to another to permit the collaborators to browse information in a synchronous manner clearly is different than the affirmative step recited in the claimed Web-based collaborative research method which includes “based on said coordinates of said pages, informing a second user of a closeness of a research by said first user”, as recited in independent claim 6 (emphasis added).

Moreover, Applicant submits that merely informing the collaborators of a change from one URL to another to permit the collaborators to browse information in a synchronous manner would not reasonably have motivated the ordinarily skilled artisan to modify Egger to arrived at the claimed invention, which, based on the coordinates of the pages, informs a second user of a closeness of a research by the first user, as recited in independent claim 6.

Indeed, neither Egger nor Anupam discloses, suggests, or for that matter even mentions, “based on said coordinates of said pages, informing a second user of a closeness of a research by said first user”, as recited in independent claim 6 (emphasis added).

Moreover, even assuming *arguendo* that it would have been obvious to combine Egger and Anupam, Applicant submits that the resulting combination clearly would not arrive at the claimed invention recited, for example, in independent claim 6.

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

18

That is, as mentioned above, neither Egger nor Anupam discloses or suggests “based on said coordinates of said pages, informing a second user of a closeness of a research by said first user”, as recited in independent claim 6 (emphasis added).

Thus, for at least the foregoing reasons, Applicant respectfully submits that it would not have been obvious to combine Egger and Anupam to arrive at the claimed invention, and even if combined, the resulting combination clearly would not disclose or suggest the claimed invention.

Applicant submits that independent claims 23 and 36 also are patentable over the alleged combination of Egger and Anupam for somewhat similar reasons as independent claim 6.

For example, independent claim 23 recites, *inter alia*:

a unit for determining coordinates for pages which are retrieved by a first user and mapping the coordinates into a space; and

a notifier for informing, based on said coordinates of said pages, a second user of a closeness of a research by said first user (emphasis added).

On the other hand, independent claim 36 recites, *inter alia*:

determining coordinates for pages which are retrieved by a first user and mapping the coordinates into a space; and

based on said coordinates of said pages, informing a second user of a closeness of a research by said first user (emphasis added).

Thus, for at least the foregoing reasons, Applicant respectfully submits that it would not have been obvious to combine Egger and Anupam to arrive at the claimed invention.

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

19

Moreover, Applicant submits that, and even if combined in the manner alleged by the Examiner, the resulting combination clearly would not disclose or suggest the claimed invention, as defined by claims 6-8, 23-33, and 36.

Accordingly, the Examiner respectfully is requested to withdraw this rejection and permit these claims to pass to immediate allowance.

IV. NEW CLAIMS

While Applicant believes that claims 6-8, 23-33, and 36 are patentable over the cited references for the reasons set forth above, new claims 37-47 are added to define more clearly and particularly the features of the invention, and to provide more varied protection for the present invention.

No new matter is added. Applicant submits that support for these claims clearly can be gleaned from the specification and drawings of the present application (e.g., see Figures 7 and 8). Such new claims also clearly are directed to the subject matter of the elected invention (e.g., user interface including proximity detection).

Applicant submits that claims 37-47 are patentable over the cited references for somewhat similar reasons as those set forth above, as well as for the additional features recited therein.

V. CONCLUSION

In view of the foregoing, Applicant submits that claims 6-8, 23-33, and 36-47, all the claims presently pending in the application, are patentably distinct over the prior art of record

Serial No. 09/893,599
Docket No. YOR920010318US1
(YOR.294)

20


and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully submitted,

Date: November 23, 2005



John J. Dresch, Esq.
Registration No. 46,672

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, Virginia 22182-3817
(703) 761-4100
Customer No. 21254

CERTIFICATE OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 the enclosed Amendment under 37 C.F.R. § 1.111 to Examiner Mohammad A. Siddiqi, Art Unit 2154 on November 23, 2005.


John J. Dresch, Esq.
Registration No. 46,672